

Attorney Docket No: 088/02319
PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Amir Loshakove et al.

Serial No.: 09/936,789

Art Unit: 3731

Filed: September 17, 2001

Examiner: Jackson, G.

For: VASCULAR CLOSURE DEVICE

REQUEST TO ACKNOWLEDGE PRIORITY CLAIM

Honorable Commissioner for
Patents
Washington, D.C. 20231

Attention: PCT Legal Office

Sir:

RECEIVED

02 MAY 2003

Legal Staff
International Division

Applicants' above-identified application includes several priority claims including a claim for benefit of the filing date of application No. 124694 filed 29 May 1998 in Israel. Although other priority claims have been acknowledged, the claim for benefit of the '694 application has not been acknowledged. This request explains applicants' entitlement to benefit of the 29 May 1998 filing date and asks that the '694 priority claim be acknowledged as proper and applicants' previously filed "EXPEDITED REQUEST FOR CORRECTED FILING RECEIPT" be granted.

BACKGROUND

International application No. PCT/IL99/00285 filed 30 May 1999 claims benefit of application No. 124694.¹ The present application claims benefit of application No. PCT/IL99/00285 which designates the U.S. In accordance with 35 U.S.C. 120 and 365(c) the present application is entitled to domestic benefit of the 30 May 1999 filing date of application No. PCT/IL99/00285. Under the Paris Convention for the Protection of Industrial Property (Paris Convention) and 35 U.S.C. 119(a) applicants are entitled to benefit of foreign

¹ 29 May 1999 was a Saturday and in accordance with Paris Convention Article 4(C)(3) the filing date of 30 May 1999 is within the priority year.

applications filed within twelve months of the 30 May 1999 filing date of the present application.

THE APPLICABLE PROVISIONS

35 U.S.C. 365(b) states that

(b) In accordance with the conditions and requirements of section 119(a) of this title and **the treaty and the Regulations**, an international application designating the United States shall be entitled to the right of priority based on a prior foreign application, or a prior international application designating at least one country other than the United States. (Emphasis added.)

Section 119(a)

The effective U.S. filing date of the present application is within one year of the 29 May 1998 filing date of the '694 priority application. The present application is in compliance with the one year and other requirements of 35 U.S.C. 119(a).

The Treaty

The Treaty at Article 8 states that

(1) The international application may contain a declaration, as prescribed in the Regulations, claiming the priority of one or more earlier applications filed in or for any country party to the Paris Convention for the Protection of Industrial Property.

(2)(a) Subject to the provisions of subparagraph (b), the conditions for, and the effect of, any priority claim declared under paragraph (1) shall be as provided in Article 4 of the Stockholm Act of the Paris Convention for the Protection of Industrial Property.

(b) The international application for which the priority of one or more earlier applications filed in or for a Contracting State is claimed may contain the designation of that State. Where, in the international application, the priority of one or more national applications filed in or for a designated State is claimed, or where the priority of an international application having designated only one State is claimed, the conditions for, and the effect of, the priority claim in that State shall be governed by the national law of that State.

The Treaty at Article 8 provides that "the effect of, any priority claim declared under paragraph (1) shall be as provided in Article 4 of the Stockholm Act of the Paris Convention...." The present application includes a request for benefit of the '694 application (a "priority claim declared") and under the present facts is entitled to benefit of the 29 May 1998 filing as provided in Article 4 of the Stockholm Act of the Paris Convention.

The Regulations (Rules)

PCT Rule 4.10(a) provides that

(a) Any declaration referred to in Article 8(1) ("priority claim") may claim the priority of one or more earlier applications filed either in or for any country party to the Paris Convention for the Protection of Industrial Property or in or for any Member of the World Trade Organization that is not party to that Convention. Any priority claim shall, subject to Rule 26bis.1, be made in the request; it shall consist of a statement to the effect that the priority of an earlier application is claimed and shall indicate:

(i) the date on which the earlier application was filed, being a date falling within the period of 12 months preceding the international filing date;

(ii) the number of the earlier application;

(iii) where the earlier application is a national application, the country party to the Paris Convention for the Protection of Industrial Property or the Member of the World Trade Organization that is not party to that Convention in which it was filed;

(iv) where the earlier application is a regional application, the authority entrusted with the granting of regional patents under the applicable regional patent treaty;

(v) where the earlier application is an international application, the receiving Office with which it was filed.

PCT Rule 26bis.2 (a) and (b) provide that

(a) Where the receiving Office or, if the receiving Office fails to do so, the International Bureau, finds that a priority claim does not comply with the requirements of Rule 4.10 or that any indication in a priority claim is not the same as the corresponding indication appearing in the priority document, the receiving Office or the International Bureau, as the case may be, shall invite the applicant to correct the priority claim.

(b) If, in response to an invitation under paragraph (a), the applicant does not, before the expiration of the time limit under Rule 26bis.1 (a), submit a notice correcting the priority claim so as to comply with the requirements of Rule 4.10, that priority claim shall, for the purposes of the procedure under the Treaty, be considered not to have been made and the receiving Office or the International Bureau, as the case may be, shall so declare and shall inform the applicant accordingly, provided that a priority claim shall not be considered not to have been made only because the indication of the number of the earlier application referred to in Rule 4.10(a)(ii) is missing or because an indication in the priority claim is not the same as the corresponding indication appearing in the priority document.

PCT Rule 4.10 requires priority claims to be

1. within twelve months of the international filing date, and
2. in the Request portion of the international application.

PCT Rule 26*bis*.2 provides that claims not in accordance with Rule 4.10 (e.g., the present claim for benefit of the '694 application which is not within twelve months of the 09 December 1999 international filing date) are notified to the applicant and if not timely corrected are considered not to have been made. Applicants' claim for benefit of the filing date of application No. 124694 filed 29 May 1998 in Israel would appear to be precluded by Rule 26*bis*.2 since it is not within twelve months of 09 December 1999 international filing date of PCT/IL99/00674 (the present application). However, this is contrary to PCT Article 8 (the Paris Convention and 35 U.S.C. 119(a)) which provides that applicants are afforded benefit of the 29 May 1998 filing in parent application PCT/IL99/00674 which rights convey to this application via Rule 4.14 which affords applicants' continuation and continuation-in-part rights.²

PCT Article 58(5)

PCT Article 58(5) states that "[i]n the case of conflict between the provisions of the Treaty and those of the Regulations, the provisions of the Treaty shall prevail."

ARGUMENT

Applicants' priority claim has been omitted from the filing receipt for the present application because of the PCT Rule 26*bis* provision that precludes a priority claim not within twelve months from the international filing date. Under the present facts Rule 26*bis* conflicts with the rights afforded by PCT Article 8 and PCT Rule 4.14. That is, applicants' second PCT application (PCT/IL99/00674) is entitled to continuation-in-part status of applicants' first PCT application (PCT/IL99/00285), however, these two application filing dates are more than seven months apart and adherence to Rule 26*bis* prohibits those priority claims within a year of the first PCT application (PCT/IL99/00285) but more than twelve months from the 09 December 1999 international filing date of PCT/IL99/00674.

² PCT Rule 4.14 affords applicants continuation and continuation-in-part status of parent applications identified in the Request. Applicants are thus entitled to the benefit of parent application PCT/IL99/00285 identified in the Request.

Applicants' first PCT application (PCT/IL99/00285) claims benefit of application No. 124694 filed 29 May 1998 in Israel and applicants' second PCT application (PCT/IL99/00674) is entitled as a continuation-in-part of PCT/IL99/00285 to the priority to the '694 application. Such rights are afforded by PCT Article 8 and Rule 4.14.

Under the present facts, the rights afforded to the present applicants by PCT Article 8 and in accordance with PCT Rule 4.14 are in conflict with PCT Rule 26*bis*.2. PCT Article 58(5) prescribes that conflicts between the Treaty and Rules are resolved in favor of the Treaty. It is requested that PCT Article 58(5) be declared as controlling with the effect that applicants' claim for benefit of the '694 application be acknowledged as proper and applicants' previously filed "EXPEDITED REQUEST FOR CORRECTED FILING RECEIPT" be granted.

This request is submitted without a fee for treatment as a petition since it is believed that consideration by the PCT Legal Office without such fee is appropriate. If a petition fee is necessary, this paper may be considered as authorization for such fee which may be charged, or any overpayment in fees be credited, to the Account of Barnes & Thornburg, Deposit Account No. 02-1010 (34201-40707).

CONCLUSION

For all of the above reasons applicants' claim for benefit of application No. 124694 filed 29 May 1998 in Israel should be acknowledged as appropriate and a corrected filing receipt listing the claim for benefit of the '694 application among the other priority claims should be provided to applicants.

Respectfully submitted,

BARNES & THORNBURG



Richard B. Lazarus
Reg. No. 48,215
(202) 289-1313

Enclosure

69075v1 DCDS01